

### **REMARKS**

The Office Action mailed June 11, 2004, has been carefully considered. The present Amendment is intended to be a complete response thereto and to place the case in condition for allowance.

Claims 11-21 and 24-27 are pending. Claims 1-10 and 22-23 have been cancelled without prejudice to the subject matter therein. Claim 11 has been amended 1) to recite “first and second legs” to provide antecedent support for claims 14-17, 19-21, 26, and 27; and 2) to insert - -and- - between “end” and “an” in the second line of the claim.

#### **THE CLAIMS ARE PROPER**

Claim 11 stands objected to because “the word ‘and’ should be inserted before the word -an- in line 2 of claim 11.” Applicant has amended claim 1 in accordance with the Examiner’s suggestion. This claim amendment is merely clarifying in nature and is neither intended to be nor believed to be a narrowing amendment. Therefore, withdrawal of the objection is respectfully requested.

#### **THE SPECIFICATION IS PROPER**

The disclosure stands objected to because some numbers in the first paragraph of page 9 do not have a unit associated therewith. Applicant has amended the specification to include units. Specifically, in the first paragraph of page 9, Applicant has added - -mm- - after “90” and  
- -g- - after “6.” These amendments do not introduce new matter because they are in accordance with other similar units in the paragraph and are self-evident. Further, any other

units would yield an impractical device. Therefore, withdrawal of the objection is respectfully requested.

#### THE CLAIMS ARE NOT INDEFINITE

Claims 14-21, 26, and 27 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to provide clear antecedent basis for “said first and second legs” as recited in claims 14-17, 19-21, 26, and 27. Applicant has amended claim 11 to recite - -first and second legs- - instead of “two legs.” Thus, amended claim 11 now provides proper antecedent basis for its dependent claims. The amendment is merely clarifying in nature and is neither intended to be nor believed to be a narrowing amendment. Accordingly, Applicant respectfully requests withdrawal of the rejection.

#### THE CLAIMS ARE NOT OBVIOUS

Claim 22 stands rejected under 35 U.S.C. § 103(a) as being obvious obvious over Seyfriedt (U.S. Patent No. 533, 923) in view of Kaufman (U.S. Patent No. 5,192,106). Claim 23 stands rejected under 35 U.S.C §103(a) as being obvious over Seyfriedt in view of Kaufman, and further in view of GB 2 035 187 (GB ‘187). The rejections are moot because claims 22 and 23 have been cancelled. However, such cancellation is solely for the purpose of issuance of a patent on the allowable claims. The cancellation is not to be deemed an acquiescence in the rejection. A *prima facie* case of obviousness has not been established because the references, taken alone or in combination, fail to disclose every element of the invention.

With regard to the rejection of claim 22 over either Seyfriedt in view of Kaufman, the references, taken alone or in combination, fails to disclose every element of the invention as

claimed. In particular, neither Seyfriedt nor Kaufman discloses that the leg ends are “capable of being brought into reversible engagement with each other at their second ends by manual exertion of a closure pressure of at least about 150 g” as required by claim 22. Nevertheless, the Examiner alleges that such a closure pressure is obvious because “the resulting aluminum or spring steel tweezers would certainly be ‘capable’ of reverse engagement at its unconnected ends by an exerted pressure of at least 150 g.” Applicant respectfully submits that the Examiner’s allegation is incorrect. First, the Examiner has not given a clear motivation for selecting a closure pressure of about 150 g and not less. The spring steel of Kaufman is capable of producing a wide range of closure pressures, including those less than 150 g. If one of ordinary skill in the art is motivated to have a closure pressure for “easy manual manipulation” as alleged by the Examiner, he/she would have selected a very low pressure of 50 g or less and not 150 g. The Examiner appears to have misunderstood the significance of such closing pressures. It is very easy to make tweezers of any material and shape if a low closure pressure would suffice. In fact, light metal tweezers capable of replacing steel tweezers (which have closure pressure of above 100 grams) require such a relatively high closure pressure that, prior to the present invention, it is anything but obvious to achieve. The present invention provides tweezers made out of light metals that have the same closure pressure as those made of steel. This is clearly unexpected over the prior art. Further, the Examiner has not provided any motivation why one of ordinary skill in the art would choose a closure pressure of greater than 150 g over any other ranges. Therefore, there is no motivation to modify the cited references to arrive at the present invention.

With regard to the rejection of claim 23 over Seyfriedt in view of GB ‘187, the references, taken alone or in combination, fail to disclose every element of the invention as claimed. Seyfriedt, as discussed above, fails to disclose “a closure pressure at least about 150

g” as recited in claim 23. The Examiner relies on GB ‘187 to show “a pair of tweezers having a bulge or projection (16a and 16b) extending inwardly from each leg so as to limit deformation of the tweezers upon manual compression thereof.” However, because Seyfriedt is deficient in disclosing the closure pressure of about 150 g, this deficiency is not satisfied by GB ‘187. Accordingly, Seyfriedt in view of GB ‘187 do not render claim 23 obvious.

For the reasons cited, the Examiner has not made a *prima facie* case of obviousness because the references, taken alone or in combination, fail to disclose every element of the presently claimed invention and because there is no motivation to arrive at the present invention. Therefore, the claims are not obvious under the meaning of 35 U.S.C §103(a).

#### ALLOWABLE SUBJECT MATTER

Applicant gratefully acknowledges the Examiner’s indication that 1) claims 11-13, 24, and 25 are allowable upon correction of the objection to claim 11; and 2) claims 14-21, 26, and 27 would be allowable if rewritten to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicant has amended claim 11 to overcome the objection and to provide proper antecedent basis for its dependent claims. Therefore, the claims are now allowable. Accordingly, Applicant respectfully requests timely issuance of a Notice of Allowance.

#### CONCLUSION

Applicant has responded to the Office Action mailed June 11, 2004. All pending claims are now believed to be allowable and favorable action is respectfully requested.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the

undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (000364-00123). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

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